

REMARKS

This responds to the Office Action dated February 27, 2007. By this response, claims 1, 8 and 9 were amended. No claims were canceled, or added. As a result, claims 1-16 remain pending in this application. Reconsideration and an early allowance is respectfully requested in view of the above amendments and the following remarks.

§102 Rejection of the Claims

A. Rejection: Claims 1, 4, 5, 8 and 16 were rejected under 35 U.S.C. § 102(b) for anticipation by Ellis (U.S. Patent No. 4,629,568).

B. Response: Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1, as amended, recites “A tankless system comprising...a flush reservoir communicatively coupled between the permeate line and the feed line; wherein the system is configured such that permeate does not enter the flush reservoir while the faucet is turned on, and permeate does not enter the flush reservoir until after the faucet is turned off, when a portion of permeate is delivered to the reservoir and then delivered to the inlet of the module to flush the module, the flush reservoir configured to substantially empty as the permeate flushes the module.” Applicant respectfully submits that the Examiner fails to make out a *prima facie* case of anticipation with respect to claim 1, as now amended. The Ellis III reference teaches two embodiments of a fluid treatment system. Both embodiments, shown in FIGs. 1 and 2, respectively, include a storage tank 24. The second embodiment, shown in FIG. 2 includes a flushing accumulator 100 which flushes the R.O. module at the conclusion of a process cycle.

(See column 7, lines 54-60 of the Ellis III reference). There is no flushing accumulator in the first embodiment shown in FIG. 1 since there is no element 100. The specification states that to "...facilitate the description, components substantially similar to those disclosed and described in connection with FIG. 1, are denoted by like characters." Therefore, the first embodiment (shown in FIG. 1) of the Ellis III patent does not have a flushing reservoir as recited in claim 1. The second embodiment (shown in FIG. 2) of the Ellis III patent includes a flushing accumulator 100 but the system is not a tankless system. Based on this, claim 1 now overcomes the rejection of claim 1 under 35 USC § 102(b) as being anticipated by Ellis (U.S. Patent No. 4,629,568).

Applicant also disagrees with Examiner's interpretation of the language in Ellis III. The Examiner seems to take the position that when the tap or faucet is open or "turned on" permeate does not enter the storage tank (flush reservoir). (See page 2 of the Office Action dated February 7, 2007). The argument set forth a portion of the paragraph from the specification. The entire paragraph from which supported the Applicant's argument is set forth here:

"The overall operation of the system is controlled by a fluid pressure operated system controller, indicated generally by the reference character 110. The controller includes a valve member 112 reciprocally mounted within a controller housing 113. The member is movable between "on" and "off" positions. In the "on" position (shown in FIG. 2), raw feed water is communicated to the R.O. unit 10 and permeate from the R.O. unit is communicated to the flushing accumulator 100 (and storage tank 24). **In the "off" position, the flow of feed water to the R.O. unit is terminated and the flushing accumulator is isolated from the permeate output of the R.O. unit and is instead communicated with the input to the R.O. unit.** Finally, the controller also controls the pressurization of the concentrate conduit 14. In the "on" position, the flow regulator 40 is enabled, thus pressurizing the conduit 14. In the "off" position, the regulator 40 is by-passed in order to reduce or terminate pressurization of the conduit 14 and hence the membrane in the R.O. unit." (See column 7, line 61 to column 8, line 13 of the Ellis III reference)

Looking at the bolded sentence in the above paragraph, Applicant notes that when the member is in the "off" position, the events that take place are associated with turning the faucet off or shutting the faucet. The member is placed in the off position when the flow of fluid is stopped. Therefore, the sentence prior to the bolded sentence indicates that there is permeate sent to the accumulator and the storage tank while the member is "on". Therefore, the Ellis III reference does not read on the recitation of claim 1 which states that "...the system is configured

such that permeate does not enter the flush reservoir while the faucet is turned on, and permeate does not enter the flush reservoir until after the faucet is turned off...” The paragraph above indicates that the permeate does flow to the accumulator when the faucet is on. This is further evidence that claim 1 now overcomes the rejection of claim 1 under 35 USC § 102(b) as being anticipated by Ellis (U.S. Patent No. 4,629,568).

Claims 2, 4, 5, and 8 depend from claim 1 and include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Moreover, Applicant has amended claim 2 to recite: the various check valves and an automatic shutoff valve and the pressures which enable these elements. Such subject matter is not discussed in the cited reference.

Claim 16 recites “...delivering a permeate from a permeate outlet of a membrane module to a faucet and while delivering permeate to the faucet, not delivering permeate to a flush reservoir...” Simply put, the Ellis III reference fails to teach this recitation as pointed out above with respect to claim 1. Therefore, claim 16 also overcomes the rejection of claim 1 under 35 USC § 102(b) as being anticipated by Ellis (U.S. Patent No. 4,629,568). Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

A. Rejection: Claims 3, 9, 10 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167).

B. Response: In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 3 depends from claim 1 and includes the recitation of that claim by its dependency. Claim 1 recites a tankless system and also recites "...a flush reservoir communicatively coupled between the permeate line and the feed line; wherein the system is configured such that permeate does not enter the flush reservoir while the faucet is turned on, and permeate does not enter the flush reservoir until after the faucet is turned off, when a portion of permeate is delivered to the reservoir and then delivered to the inlet of the module to flush the module, the flush reservoir configured to substantially empty as the permeate flushes the module." Ellis does not teach the limitations of a tankless system or the system configured such that permeate does not enter the flush reservoir while the faucet is turned on. The Gramms et al. reference does not cure these shortcomings. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references fail to teach or suggest all the claim limitations.

Claim 9 recites "...the system is configured to not sent any permeate to the reservoir while the faucet is open and then to temporarily fill the reservoir with an amount of permeate after the faucet is closed and to deliver the amount of permeate to the module inlet via the feed line." Ellis does not teach the limitations of a tankless system or the system configured such that permeate does not enter the flush reservoir while the faucet is turned on. The Gramms et al. reference does not cure these shortcomings. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references fail to teach or suggest all the claim limitations.

Claims 10, and 12-15 depend from claim 9 and include the limitations of that claim by their dependency. As a result, these claims also overcome the Examiner's rejection for the same reason as set forth above with respect to claim 9.

As a result, the Examiner's rejection of 3, 9, 10 and 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167) is overcome.

C. Rejection: Claims 2, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Hart (U.S. Patent No. 6,110,360).

D. Response: Claims 2, 6 and 7 depend from claim 1 and includes the recitation of that claim by its dependency. Claim 1 recites a tankless system and also recites "...a flush reservoir communicatively coupled between the permeate line and the feed line; wherein the system is configured such that permeate does not enter the flush reservoir while the faucet is turned on, and permeate does not enter the flush reservoir until after the faucet is turned off, when a portion of permeate is delivered to the reservoir and then delivered to the inlet of the module to flush the module, the flush reservoir configured to substantially empty as the permeate flushes the module." Ellis does not teach the limitations of a tankless system or the system configured such that permeate does not enter the flush reservoir while the faucet is turned on. The Hart reference also does not cure these shortcomings. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references fail to teach or suggest all the claim limitations and claims 2, 6 and 7 now overcome the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Hart (U.S. Patent No. 6,110,360).

E. Rejection: Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167) as applied to claims 8-10 above, and further in view of Hart (U.S. Patent No. 6,110,360).

F. Response: Claims 11 and 13 depend from claim 9 and include the limitations of that claim by their dependency. Claim 9 recites "...the system is configured to not sent any permeate to the reservoir while the faucet is open and then to temporarily fill the reservoir with an amount of permeate after the faucet is closed and to deliver the amount of permeate to the module inlet via the feed line." Ellis does not teach the limitations of a tankless system or the system configured such that permeate does not enter the flush reservoir while the faucet is turned on.

Neither of the Gramms et al. reference or the Hart reference cure these shortcomings. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references fail to teach or suggest all the claim limitations. As a result, claims 11 and 13 now overcome the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167) as applied to claims 8-10 above, and further in view of Hart (U.S. Patent No. 6,110,360).

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHIA KUNG ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6977

Date

4/27/07

By

Richard E. Billion

Richard E. Billion

Reg. No. 32,836

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of April, 2007.

RICHARD E. Billion

Name

Richard E. Billion

Signature